Remarks

The Office Action mailed July 5, 2005 has been carefully reviewed and the foregoing remarks have been made in consequence thereof.

Claims 1-15 are now pending in this application. Claims 1-15 stand rejected.

The rejection of Claims 1-2, 5, and 8, 9, 12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Wolpa (U.S. 5,992,073) is respectfully traversed.

Wolpa describes an identification device 10 that is coupled to an exterior surface 16 of a storage container 15. Identification device 10 includes a label holder 20, a label engagement means 30, a label means 40, and an attachment means 50. Label holder 20 includes a box frame 22 having a slot entrance aperture 34 sized to receive the label means 40 therein. Box frame 22 is substantially three-dimensionally rectangular, such that the exterior wall 24 of frame 22 is substantially parallel to the interior wall of frame 22. As such, when frame 22 is coupled tangentially to container surface 16, only the center portion of box frame 22 is in contact with surface 16. Identification device 10 is attached to the exterior surface 16 of the storage container 15 by a strap 52 or through the use of an adhesive bonding 54. Notably, Wolpa does not describe or suggest a flexible tag holder wherein the cavity has a circumferential length including circumferentially spaced exterior edges that are positionable substantially flush against the container exterior surface.

Claim 1 recites a container identification system comprising "a flexible tag holder coupled to said fastener mechanism and comprising an outer surface and an inner surface . . . said inner surface defining a cavity within said tag holder . . . said cavity having a circumferential length that is less than the length of said fastener mechanism such that a pair of circumferentially spaced outer edges of said cavity are positionable substantially flush against an outer surface of the container when said container identification system is coupled to the container . . . said cavity sized to receive indicia therein for identifying the container."

Wolpa does not describe nor suggest a container identification system as recited in Claim 1. Specifically, Wolpa does not describe nor suggest a flexible tag holder having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable

substantially flush against an outer surface of the container when the container identification system is coupled to the container. Rather, in contrast to the present invention, Wolpa describes a label holder that comprises a box frame such that when the box frame is coupled to the container, the outer edges of the box frame are positioned a distance outward from the exterior surface of the container.

Claims 2, 5, and 8 depend, directly or indirectly from independent Claim 1. When the recitations of Claims 2, 5, and 8 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2, 5, and 8 likewise are patentable over Wolpa.

Claim 9 recites a method of identifying a container comprising "coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container . . . ."

Wolpa does not describe nor suggest a method as recited in Claim 9. Specifically Wolpa does not describe nor suggest a method comprising coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container. Rather, in contrast to the present invention, Wolpa describes a label holder that comprises a box frame such that when the box frame is coupled to the container, the outer edges of the box frame are positioned a distance outward from the exterior surface of the container.

Claims 12 and 15 depend, directly or indirectly from independent Claim 9. When the recitations of Claims 12 and 15 are considered in combination with the recitations of Claim 9, Applicant submits that dependent Claims 12 and 15 likewise are patentable over Wolpa.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102(b) rejection of Claims 1-2, 5, and 8, 9, 12, and 15 be withdrawn.

The rejection of Claims 3-4 and Claims 10-11 under 35 U.S.C § 103 as being unpatentable over Wolpa in view of Siegrist (U.S. 6,550,813) is respectfully traversed.

Wolpa is described above. Siegrist describes a reusable identification tag 50 having a substantially flat substrate 51 that is adapted to receive graphics and indicia 52 thereon. Specifically, at column 5, lines 46-50, Siegrist recites that the "only limitations regarding shape are that the invention should be substantially flat in the top and bottom sides." Substrate 51 is covered with a top layer 53 fabricated from a non-porous erasable film. Tag 50 is attached to an item using a string or strap extended through a hole 54 near an outer perimeter of tag 50. Notably, Siegrist does not describe nor suggest a tag formed from a flexible material such that the circumferentially spaced ends of the cavity are positionable substantially flush against the container when attached. Furthermore, Siegrist does not describe an identification tag which wraps around the container. Specifically, the tag in Siegrist hangs from the container such that only the strap is positionable substantially flush against the container.

Claims 3-4 depend from independent Claim 1 which recites a container identification system comprising "a flexible tag holder coupled to said fastener mechanism and comprising an outer surface and an inner surface . . . said inner surface defining a cavity within said tag holder . . . said cavity having a circumferential length that is less than the length of said fastener mechanism such that a pair of circumferentially spaced outer edges of said cavity are positionable substantially flush against an outer surface of the container when said container identification system is coupled to the container . . . said cavity sized to receive indicia therein for identifying the container."

Neither Wolpa nor Siegrist, considered alone or in combination, describe or suggest a container identification system as recited in Claim 1. Specifically no combination of Wolpa or Siegrist describe or suggest a tag holder having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container.

Rather Wolpa describes coupling an identification tag to the side of a container using a box-like frame as the label holder wherein the edges of the box frame are not positionable substantially flush against the container exterior surface, and Siegrist describes an identification device including a substantially flat substrate. As such, neither Wolpa nor Siegrist describes nor suggests an identification system having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container. Accordingly, Claim 1 is patentable over Wolpa in view of Siegrist.

When the recitations of Claims 3-4 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 3-4 likewise are patentable over Wolpa in view of Siegrist.

Claims 10-11 depend from independent Claim 9 which recites a method of identifying a container comprising "coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container . . . ."

Neither Wolpa nor Siegrist, considered alone or in combination, describe or suggest a method of identifying a container as recited in Claim 9. Specifically, no combination of Wolpa or Siegrist describe or suggest a method comprising coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container.

Rather Wolpa describes coupling an identification tag to the side of a container using a box-like frame as the label holder wherein the edges of the box frame are not positionable

substantially flush against the container exterior surface, and Siegrist describes an identification device including a substantially flat substrate. As such, neither Wolpa nor Siegrist describes nor suggests a method comprising coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container. Accordingly, Claim 9 is patentable over Wolpa in view of Siegrist.

When the recitations of Claims 10-11 are considered in combination with the recitations of Claim 9, Applicant submits that dependent Claims 10-11 likewise are patentable over Wolpa in view of Siegrist.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 3-4 and 10-11 be withdrawn.

The rejection of Claims 6-7 and Claims 13-14 under 35 U.S.C § 103(a) as being unpatentable over Wolpa in view of Siebe (U.S. 1,761,995) is respectfully traversed.

Wolpa is described above. Siebe describes a price tag holder including a frame 1, formed of a sheet of metal plate 2. The holder is fabricated such that the bottom and end edges are folded to permit removal and replacement of a price card 5. The holder further includes a body plate 2 having tongues 6, 7, and 8 bent back on a rear side of the plate 2 to engage a wire 9. Wire 9 encloses an article of merchandise to attach frame 1 thereon. Specifically, frame 1 is substantially rectangular such that the exterior wall of the frame is parallel to the interior wall of the frame. Siebe does not describe nor suggest a tag formed from a flexible material such that the circumferentially spaced ends of the cavity are postitionable substantially flush against the container when attached.

Claims 6-7 depend from independent Claim 1 which recites a container identification system comprising "a flexible tag holder coupled to said fastener mechanism and comprising an outer surface and an inner surface . . . said inner surface defining a cavity within said tag holder . . . said cavity having a circumferential length that is less than the length of said

fastener mechanism such that a pair of circumferentially spaced outer edges of said cavity are positionable substantially flush against an outer surface of the container when said container identification system is coupled to the container . . . said cavity sized to receive indicia therein for identifying the container."

Neither Wolpa nor Siebe, considered alone or in combination, describe or suggest the a container identification system as recited in Claim 1. Specifically no combination of Wolpa or Siebe describe or suggest a tag holder having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container.

Rather Wolpa describes coupling an identification tag to the side of a container using a box-like frame as the label holder wherein the edges of the box frame are not positionable substantially flush against the container exterior surface, and Siebe describes an identification tag that is coupled to the side of a container using a rectangular frame as the label holder. As such, neither Wolpa nor Siebe describes nor suggests an identification system having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container. Accordingly, Claim 1 is patentable over Wolpa in view of Siebe.

When the recitations of Claims 6-7 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 6-7 likewise are patentable over Wolpa in view of Siebe.

Claims 13-14 depend from independent Claim 9 which recites a method of identifying a container comprising "coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container . . . ."

Neither Wolpa nor Siebe, considered alone or in combination, describe or suggest a method of identifying a container as recited in Claim 9. Specifically, no combination of Wolpa or Siebe describe or suggest a method comprising coupling a container identification system including a flexible tag holder and a fastening mechanism to a container, such that the fastener mechanism extends for a length at least partially around an outer perimeter of the container, and wherein the tag holder has a circumferential length defined between a pair of circumferentially spaced edges that is shorter than the length of the fastening mechanism such that the cavity circumferentially spaced outer edges are positioned substantially flush against an outer surface of the container.

Rather Wolpa describes coupling an identification tag to the side of a container using a box-like frame as the label holder wherein the edges of the box frame are not positionable substantially flush against the container exterior surface, and Siebe describes coupling an identification tag to the side of a container using a rectangular frame as the label holder. As such, neither Wolpa nor Siebe describes nor suggests an identification system having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container. Accordingly, Claim 9 is patentable over Wolpa in view of Siebe.

When the recitations of Claims 13-14 are considered in combination with the recitations of Claim 9, Applicant submits that dependent Claims 13-14 likewise are patentable over Wolpa in view of Siebe.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 6-7 and 13-14 be withdrawn.

The rejection of Claims 1-2, 5, and 8 under 35 U.S.C. §103(a) as being unpatentable over Reinsberg (U.S. 3,586,220) is respectfully traversed.

Reinsberg describes an identification holder 10 having a pair of sheets 11 and 12 with their peripheral edge marginal regions secured together so as to provide an enclosed area between their opposing sufaces adapted to hold an inserted sheet. The front sheet 11 is formed with an enlarged central opening behind which a transparent sheet 14 as placed. The back of sheet 12 further includes an elongated linear slot 26 through which a sheet can be

maneuvered. Specifically Reinsberg describes a slot through which a sheet must be maneuvered. Reinsberg does not describe a cavity which is sized to receive indicia.

Claims 2, 5, and 8 depend, directly or indirectly from independent Claim 1 which recites a container identification system comprising "a flexible tag holder coupled to said fastener mechanism and comprising an outer surface and an inner surface . . . said inner surface defining a cavity within said tag holder . . . said cavity having a circumferential length that is less than the length of said fastener mechanism such that a pair of circumferentially spaced outer edges of said cavity are positionable substantially flush against an outer surface of the container when said container identification system is coupled to the container . . . said cavity sized to receive indicia therein for identifying the container."

Reinsberg does not describe nor suggest a container identification system as recited in Claim 1. Specifically, Reinsberg does not describe nor suggest a tag holder having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container.

Rather Reinsberg describes a container identification system having a slot through which a sheet must be maneuvered. As such Reinsberg does not describe nor suggest a tag holder having a cavity having a circumferential length that is less than the length of the fastener mechanism such that a pair of circumferentially spaced outer edges of the cavity are positionable substantially flush against an outer surface of the container when the container identification system is coupled to the container.

Moreover, obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Wilson. As explained by the Federal Circuit, "to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicant." In re Kotzab, 54 U.S.P.Q.2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the

desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

> it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 U.S.P.Q. 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

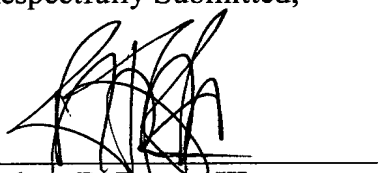
Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for at least this reason, Applicant requests that the Section 103 rejection of Claim 1 be withdrawn.

When the recitations of Claims 2, 5, and 8 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2, 5, and 8 likewise are patentable over Reinsberg.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-2, 5, and 8 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Robert B. Reeser III
Registration No. 45,548
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070